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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,508	11/22/2000	John Wallace Parce	01-000461US	5229

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EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/721,508

Applicant(s)

PARCE ET AL.

Examiner

My-Chau T. Tran

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 75-107 is/are pending in the application.
- 4a) Of the above claim(s) 91-105 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 75-77, 79, 80, 82-86 and 88-90 is/are allowed.
- 6) ☒ Claim(s) 78, 81 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Applicant's amendment filed 10/28/02 and 12/18/02 in Paper No. 16 and 17 respectively is acknowledged and entered. Claims 91-105 are added. Claims 75-107 are pending.
2. The amendment filed on 12/18/02 in Paper No. 17 is to correct the error of the amendment filed on 10/7/02 in Paper No. 13. The error is that the amendment that could not be entered because there paragraphs that applicant has indicated (page 38 line 4 and line 25) to be amended do not correlate with what is found in the specification.

### ***Drawings***

3. The corrected or substitute drawings were received on 10/7/02. These drawings are acceptable.
4. Claims 75-107 are treated on the merit in this Office Action.

### ***Election/Restrictions***

5. Newly submitted claims 91-107 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention of claims 75-90 is drawn to an apparatus that comprises of a first and second plates. The invention of claims 91-107 is drawn to an apparatus that comprises a substrate. Because they're different patentability considerations are involved for each inventions. For example, a patentability determination for claims 75-90 would involve a determination of the

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patentability of an apparatus that comprises the combination of a first and second plates (independent of its use) while a patentability determination for claims 91-107 would involve a consideration of the patentability of a substrate of an apparatus. These considerations are very different in nature.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 91-107 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Maintained Rejections***

#### ***Claim Rejections - 35 USC § 112***

7. Claims 78, 81, and 87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 78 and 81 recites an apparatus that includes an array of sample wells, which conform to a format of a 96, 192, 384, or 1536 well plate.

Claim 87 recites a method in which an array of sample is from an array of sample wells. The array of sample wells conforms to a format of a 96, 192, 384, or 1536 well plate.

The specification discloses an apparatus that include bead resting wells (pg. 28, lines 34-38) and an apparatus that contained multiwell micro plates (pg. 36, line 14; ref. #711 of fig. 7). A method in which test compounds are immobilized on beads in a parallel assay system the parallel channels may be fabricated to include bead resting wells (pg. 28, lines 24-38).

Nowhere in the specification is there a teaching of sample wells that conform to a format of a 96, 192, 384, or 1536 well plate. Additionally in the multiwell micro plates (ref. #711) of fig. 7, the wells are not in a format of a 96 well plate.

In the event that applicant believes support for the amendment is available in the specification. It is respectfully requested that applicant point to the page and line number where such support maybe found.

### ***Response to Arguments***

8. Applicant's arguments in view of the rejection of Claims 78, 81, and 87 under 35 U.S.C. 112, first paragraph, filed on 10/7/02 has been fully considered but they are not persuasive.

Applicant contends that the disclosure of "multiwell microplates" in the specification (pg. 36, line 14 and figure 7, ref. #711) provides adequate support for the claims covering 96, 192, 384, or 1536 well plates because one skilled in the art at the time of invention would have recognized those as standard plate configurations.

It is the examiner position that a genus (multiwell microplates) is not descriptive in defining a specific species (96, 192, 384, or 1536 well plates). Further, the six references provided by the applicant to demonstrate that the disclosure of "multiwell microplates" in the

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specification would provides adequate support for the claims covering 96, 192, 384, or 1536 well plates have been fully considered but they are not persuasive. Because these reference shows that "multiwell plates or microplates" is further define by a specific format ("96, 192, 384, or 1536 well plates"). For example, Warner et al. (US Patent 5,604,130) states that "...*the present invention may be produced for use with a variety of multiwell plate formats including but not limited to 6-wel plates, 12-well plates, 24-well plates, 36-well plates, 48-well plates, 96-well plates, 384-well plates, and the like*" (col. 7, lines 5-9). Therefore, there are no adequate support for claims 78, 81, and 87.

#### ***Allowable Subject Matter***

9. Claims 75-77, 79-80, 82-86, and 88-90 are allowed.

#### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct  
February 7, 2003

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER